

Application No.: 09/204,390

Attorney Docket No.: 72167.000061

REMARKS

Claims 1-21 are pending in this application. By this Amendment, claims 1, 10 and 18 are amended.

In the present Amendment, the claims have been amended to further clarify the claimed invention. Applicant submits that in general Applicant does not believe the various amendments to be narrowing to the amended claims. Rather, Applicant submits that the amendments simply draw out what was already found, either explicitly or implicitly, in the claims.

No new matter is presented by the Amendment. Support for the amendments may be found, for example, on page 5, lines 7-36; page 6, lines 1-15; page 7, lines 17-23; and page 8, lines 3-28; and in the drawings.

Applicant respectfully requests reconsideration of the application.

A. The 35 U.S.C. § 101 Rejection

In the Office Action, claims 1-21 are rejected under 35 U.S.C. 101. The Office Action asserts that the claimed invention is directed to non-statutory subject matter. The Office Action further asserts that for a claim to be statutory under 35 U.S.C. 101 the following two conditions must be met: (1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result, AND, (2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result. The Office Action further asserts that the invention in the body of the claim must recite technology, and that if the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory.

Applicant respectfully traverses this rejection which has no basis under 35 U.S.C. § 101. It is well established that § 101 requires that (1) the invention have utility or operativeness and (2) the invention falls within one of the proper subject matter categories (process, machine, article of manufacture; and composition of matter).

The Examiner's rejection does not claim that the present invention has no utility - **which** it clearly does. Regarding subject matter category, the invention of each of the claims is recited as a "method," which plainly falls within the ambit of the "process" category set forth in §101.

MPEP §706.03(a), which governs rejections under § 101, provides no support for the rejection set forth in the Office Action. MPEP §706.03(a) provides that rejections under §101 may be made for the following reasons: nonstatutory subject matter (printed matter, naturally occurring article, scientific principle), lack of utility, and inoperativeness. None of these apply here. Applicant is unaware of any requirement imposed by the Patent Statute or controlling precedent requiring an Applicant to recite structure in a method claim.

However, in response to the Examiner's comments and in order to expedite prosecution of this application, Applicant has amended the preamble and the body of independent claims 1, 10 and 18 to recite a "processing system." As noted above, ample support for the amendments may be found, for example, on page 5, lines 7-36; page 6, lines 1-15; page 7, lines 17-23; page 8, lines 3-28; and in the drawings, for example.

Applicant submits that such amendments to the claims moots the issue regarding §101. A method implemented with a processing system clearly recites "technology." Applicant submits that the claims clearly now recite "technology" and requests that the §101 rejection be withdrawn.

B. The 35 U.S.C. §103 Rejection

In the Office Action, claims 1-21 are rejected under 35 U.S.C. 103(a) as being anticipated by Melchione et al (U.S. Patent No. 5,930,764). This rejection is traversed.

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1. The Propriety of the 35 U.S.C. §103 Rejection

Applicant respectfully submits that the rejection under the applied art to Melchione is improper

As set forth in M.P.E.P 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. M.P.E.P 706.02(j) indicates that after indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P 706.02(j) references the well known requirements of *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Further, M.P.E.P 706.02(j) notes that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.

With respect to the present rejection under 35 U.S.C. §103, the basis of the rejection has not been set forth in the Office Action. That is, the Office Action does not appear to set forth the differences in the rejected claims vis-à-vis Melchione, nor does the Office Action appear to set forth any proposed modification of Melchione. Further, there is no motivation set forth to

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support any such modification of Melchione. Accordingly, the basis of the rejection and the manner in which 35 U.S.C. §103 is being applied is fully unclear.

As noted above, M.P.E.P 706.02(j) notes that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply. Applicant submits that, based on the above, the basis of the asserted rejection has not been properly communicated, so as to allow Applicant to understand the basis of the rejection and to respond to the rejection.

Applicant requests that the rejection under 35 U.S.C. §103 be withdrawn. Alternatively, Applicant requests the Examiner to clarify the grounds of rejection such that Applicant and the Examiner can work together effectively and productively to further prosecution on this case.

2. The 35 U.S.C. §103 Rejection and the Claims

On page 3, the Office Action sets forth details of the rejection in terms of sections of Melchione being relied upon. In particular, the Office Action appears to assert features of Melchione against the features of claim 1.

That is, the Office Action reflects that Melchione teaches a method for processing transaction data comprising the steps of: receiving transaction data, the transaction data containing account numbers (abstract, figs. 1-8, col. 1, lines 53-62, col. 2, lines 20-37, col. 7 lines, 23-59, col. 14, lines 47-65); identifying non-issuer account numbers which represent accounts not issued by an issuer (col. 20, lines 10-16, col. 23, lines 1-17, col. 35, lines 29-67); matching the identified non-issuer account numbers with account numbers representing (col. 20, lines 10-16, col. 23, lines 1-17, col. 35, lines 29-67); account issued by the issuer (col. 20, lines 10-16, col. 23, lines 1-17, col. 35, lines 29-67, col. 38, lines 55-60). These assertions are traversed. It is submitted that Melchione fails to teach or suggest the features of the pending

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claims for the reasons set forth herein, as well as the reasons set forth in the July 8, 2004 Response.

Claim 1 recites the features of, in particular: **identifying** non-issuer account numbers which represent accounts not issued by an issuer using the processing system; and **matching the** identified non-issuer account numbers with account numbers representing accounts issued by the issuer. Melchione fails to teach such method steps and the interrelationship between such method steps.

In the Abstract, Melchione teaches a sales process support system and method for identifying sales targets using a centralized database to improve marketing success. The system includes a central database that receives comprehensive information from a variety of internal and external feeds, and standardizes and households the information in a three-level hierarchy (households, customers, and accounts) for use by a financial institution. Melchione teaches that the comprehensive information stored on the central database is accessed through micromarketing workstations to generate lists of sales leads for marketing campaigns. A database engine is provided for generating logical access paths for accessing data on the central database to increase speed and efficiency of the central database. The system distributes sales leads electronically to branch networks, where the sales leads are used to target customers for marketing campaigns.

Applicant also notes column 14, lines 48-64 of Melchione, which the Office Action refers to in the rejection. Melchione teaches that a central customer information system ("CCIS") preferably includes a relationship profile component, an account management component, a lead management system, or a sales tracking and reporting (management information system or "MIS") component. Each component can generate reports, which are provided to the users

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(branch management) to complete the sales process. The electronic sales and service support system is preferably capable of interfacing with a system for opening a single account that includes a full range of financial components. Thus, the integrated system of the Melchione invention also includes a system for opening an account, preferably in a single session. The system is preferably in communication with the central database, micromarketing centers, central customer information systems and branch systems of the present invention so that data can pass between these systems where legal and appropriate.

The Office Action further references column 20, lines 10-16. Melchione teaches aspects of an account path. Melchione describes that an account path allows the user to select households (or other keys) that fit a single account level criteria. That is, an account path provides all households that contain accounts of a given product where, optionally, the product possesses particular attributes. Melchione teaches that if the user wants to specify the product code (indicative of a product) at a service type level, the query can be answered in one step by using flags and summary variables at the household level. Melchione goes on to describe that, however, even in this case the user may want to specify other characteristics that the product must have (open date, individual account balance, etc.) that are only available at the account level. This query will pick all households that have accounts with the appropriate product and related characteristics. A DISTINCT clause can be used in a query to eliminate duplicate households that will occur if a household has more than one account of the requested type. The user may want households that have EITHER one product with certain characteristics OR another product with certain other characteristics. Or the user may want households that at the same time (AND) contain another type of product, or do not (NOT) contain accounts of another type.

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This disclosure of Melchione fails to teach or suggest claim 1. Applicant acknowledges that such teaching of Melchione describes, for example, that duplicate households may be eliminated. Relatedly, the concept of effecting data processing to eliminate duplicate entries of data is known. However, claim 1 recites the manipulation of particular data in a particular manner, i.e., in the "identifying" and "matching" steps noted above. Such language of claim 1 goes well beyond the general concept of sorting and matching data based on criteria, which is of coarse known in the art.

To explain further, on page 5, in what appears to be an overview of the applied rejection, the Office Action asserts that claims 1-21 merely describe the old and well known practice of sorting and matching data within a database using user defined criteria. The Office Action further asserts that because it was so well known it would have been obvious to one skilled in the art at the time of the invention to have been aware of those facts and use them in practicing this invention. At the bottom of page 4, the Office Action also asserts that "Melchione uses different words to describe the Applicant's invention."

It is respectfully submitted that such assertions in the Office Action are simply unsupportable, and fail to reflect the features of the claimed invention. Claim 1, for example, recites a specific manipulation of data and does *not* recite merely sorting and matching data within a database using user defined criteria. Such assertions in the Office Action render portions of claim 1 meaningless, including in particular the claimed features of "identifying non-issuer account numbers which represent accounts not issued by an issuer using the processing system; and matching the identified non-issuer account numbers with account numbers representing accounts issued by the issuer".

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Applicant has reviewed the other portions of Melchione specifically noted in the Office Action and submit that these portions are no more relevant than the teachings of Melchione noted above.

For example, in column 35, lines 30-67, Melchione teaches a general customer information screen displays general customer information, including products owned, services used, and customer behavior. The customer information on this screen includes the primary name and address for the customer and the "best" phone number based on internal feeds into the central database and external matches, and the name of the customer's personal banker (if any). The customer information on this screen also includes details of the customer's activities, including the number of checks written, teller transactions, ATM usage, electronic and phone banking services used, *payments made with checks from financial competitors*, current and historic balances, customer net revenue, credit card usage patterns, the branch where the customer's primary account is domiciled, the customer's preferred branches based on frequency of use, and other products and services used by the customer. These features of Melchione fail to teach or suggest claim 1. In particular, the Melchione disclosure of "payments made with checks from financial competitors" fails to teach the "identifying" and "matching" features of claim 1.

Accordingly, Applicant respectfully submits that Melchione fails to teach or suggest the invention as recited in claim 1. Further, Applicant respectfully submits that claims 10 and 18 recite patentable subject matter for reasons similar to those set forth above with respect to claim 1.

Further, the various dependent claims recite patentable subject matter at least for their various dependencies on the independent claims, as well as for the additional subject matter such dependent claims recite.

For example, claim 2 recites a method as recited in claim 1, wherein the matching step comprises: identifying a consumer associated with at least one of the identified non-issuer account numbers; determining if the identified consumer is a customer of the issuer, the customer having an issuer account number representing an issuer account issued by the issuer, and linking the non-issuer account number of the customer with the issuer account number of the customer.

The Office Action on page 3, last paragraph, asserts that Melchione teaches linking the non-issuer account number of the customer with the issuer account number of the customer (col. 44, lines 30-67). However, such section of Melchione teaches, for example, upon contacting the bank, typically by entering a branch, a customer is greeted and entered into a queue. This initial greeting step is useful for identifying new customers. For a new customer, name, address, and purpose of visit will be requested. For existing customers, the customer is identified in several different ways: by account number, name (either alone or with address and zip code), social security number, and bankcard, either by entry of the number or by bankcard dip and personal identification code (PIC) entry. In column 44, line 48 specifically, Melchione describes that a greeter creates (in the case of a new customer) or calls up (in the case of an existing customer) a profile that allows the (the teller or personal banker) to know as much about the customer as is available; including, but not limited to, information on credit cards, mortgages, tax shelters, etc. However, Applicant submits that such disclosure of Melchione is little more than data acquisition and presentment. Such teaching of Melchione fails to describe the various features of claim 2, including in particular, the "linking the non-issuer account number of the customer with the issuer account number of the customer".

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Various teachings of Melchione are described above. It is submitted that the other disclosure of Melchione is no more relevant than those portions herein noted. Accordingly, reconsideration of the rejection under 35 U.S.C. § 103 and allowance of the rejected claims are respectfully requested.

3. The New Grounds of Rejection Mooting Applicant's Prior Arguments

On page 5, the Office Action asserts that Applicant's arguments (set forth in the July 8, 2004 Response) with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection. Applicant respectfully traverses this assertion in the Office Action. Applicant submits that such arguments set forth in the July 8, 2004 Response are not moot and should be considered in conjunction with Applicant's remarks set forth above.

That is, claims 1-21 were previously rejected under 35 U.S.C. § 102 based on the teachings of Melchione. In the present rejection, claims 1-21 are rejected under 35 U.S.C. § 103 based on the teachings of Melchione. Applicant's previous remarks (as set forth in the July 8, 2004 Response) went to the deficiencies of Melchione vis-à-vis teaching the claimed invention. Given that generally speaking the claims are still being rejected under the teachings of Melchione, Applicant submits that the prior arguments should be considered.

In particular, on page 10, line 6+, of the July 8, 2004 Response, Applicant argued that none of the cited portions of Melchione disclose receiving transaction data containing account numbers and matching non-issuer account numbers with issuer account numbers. This submission by Applicant is very much germane to the presently applied rejection and was not addressed in the Office Action. Various other arguments set forth in the July 8, 2004 Response are very much germane to the issues at hand, and have not been addressed.

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C. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to favorable disposition of the application.

Respectfully submitted,

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